

**REMARKS**

Claims 18-22 remain in the present application. Claims 1-17 and 23-27 were canceled. Claims 28-31 have been added herein. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action of May 5, 2005, the following actions were taken:

- (1) Claims 18 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yang et al. (U.S. Patent No. 6,123,757).
- (2) Claims 18-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Marshall et al. (U.S. Patent No. 5,275,646).
- (3) Claims 18-22 were rejected under 35 U.S.C. § 102(e) as being anticipated by Moreland (U.S. Patent No. 6,261,347).

It is respectfully submitted that the presently pending claims be examined and allowed. No new matter is added by the addition of the new claim set, as new claim 28 reflects originally filed dependent claim 22.

**Rejections under 35 U.S.C. § 102**

Claims 18-22 (including independent claim 18) were rejected under 35 U.S.C. 102 over three individual references. Before discussing the rejections, it is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. § 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), *cert. denied* 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), *cert denied*, 469 U.S. 851 (1984), "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." "The identical invention must be

shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

#### Present Invention

Amended independent claim 18 of the present application teaches a method of releasing an odor from a printed image, comprising the steps of: providing a substrate having printed thereon an image comprising an electro-thermal odor-releasing ink; providing an energy source; and completing an electric circuit between the electro-thermal odor-releasing ink and the energy source, thereby releasing an odor.

New claim 28 of the present application teaches a method of releasing an odor from a printed image comprising the steps of: providing a substrate having printed thereon an image comprising an electro-thermal odor-releasing ink; providing an energy source; and completing a circuit between the electro-thermal odor-releasing ink and the energy source by coupling the energy source to the electro-thermal odor-releasing ink with a conductive element, thereby releasing an odor.

Thus, the presently pending claims include the limitations of either: i) applying an electric current through an image printed on a substrate to release an odor from an ink forming the image; or ii) completing a circuit between the ink and the energy source by coupling the energy source to the ink with a conductive element to release an odor from the ink. Applicant respectfully submits that these limitations are not taught or suggested by the references cited in the Office Action.

#### Discussion

Claims 18 and 20 were rejected under 35 U.S.C. 102(b) as being anticipated by Yang et al. (hereinafter “Yang”). Yang teaches a fragrant ink for ink-jet printers that “cause[s] the paper printed out by the ink-jet printer to emit a pleasant scent during the printing operation without influencing the printing quality nor increasing manufacturing costs” (Col. 6, lines 38-41). There is no mention in Yang of an electric energy source. As such, there is clearly no teaching or suggestion in Yang to complete an electric circuit between scented ink of an image printed on a substrate and an energy source. In addition, there is no mention in Yang of a conductive element: as such there is clearly no teaching or suggestion in Yang to completing,

with a conductive element, a circuit between scented ink of an image printed on a substrate and an energy source.

Thus, each and every element of amended independent claim 18 and new independent claim 28 is neither present in nor suggested by Yang.

Claims 18-22 were rejected under 35 U.S.C. 102(b) as being anticipated by Marshall. Marshall teaches an ink composition in which no methanol, ethanol, MEK or other such low molecular weight organic solvent is required in order to avoid the use of volatile, flammable and environmentally undesirable solvents. The only reference in the Marshall specification to an energy source is the use of a light source to cure a printed image, e.g., a mercury arc lamp, a UV-A, -B or -C light source, etc. Thus, Marshall does not teach or suggest applying an electric current through an image printed on a substrate to release an odor from an ink forming the image, nor does Marshall teach or suggest completing a circuit between the ink and the energy source by coupling the energy source to the ink with a conductive element to release an odor from the ink.

Thus, each and every element of amended independent claim 18 and new claim 28 is neither present in nor suggested by Marshall.

Claims 18-22 were rejected under 35 U.S.C. 102(e) as being anticipated by Moreland. Moreland teaches a scented jet ink and printed articles formed therefrom for applying scented images to a substrate. There is no reference in the Moreland specification to an energy source. As such, Moreland clearly fails to teach or suggest applying an electric current through an image printed on a substrate to release an odor from an ink forming the image. Moreland also fails to teach or suggest completing a circuit between the ink and the energy source by coupling the energy source to the ink with a conductive element to release an odor from the ink.

Thus, each and every element of amended independent claim 18 and new independent claim 28 is neither present in nor suggested by Moreland.

In view of the foregoing, Applicant believes that independent claims 18 and 28 present allowable subject matter and allowance is respectfully requested. In

addition, as claims 19-22 and 29-31 depend from an allowable independent claim, they are each in allowable condition.

If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025

Dated this 5 day of August, 2005.

Respectfully submitted,



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